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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of
Bergert, Thomas F.

Serial No.: 09/473,136

Filed: December 28, 1999

For: Recreational Outing
Reservation System

Examiner: A. Kalinowski

Art Unit: 3626

REPLY BRIEF ON APPEAL

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer mailed March 9, 2005, Applicant hereby replies pursuant to 37 CFR 1.193. For the reasons set forth more fully below, Applicant submits that the Examiner has failed to establish a prima facie case of obviousness against the claims as they currently stand.

The present invention solves an entirely different problem than any contemplated by the references of record. The present invention is concerned with facilitating arrangement of multi-participant recreational outings at one of several available venues, and the independent claims as they stand in this appeal are directed to the embodiment of the invention wherein notifying event partners is addressed after a known available reservation option has been selected.

Applicant argued in its Appeal Brief that the references as combined by the Examiner do not teach or suggest the invention as claimed. In addressing Applicant's arguments, the Examiner's response mailed March 9, 2005 points out that the Examiner only used the Davies and GolfAgent references (the primary references cited against the independent claims) for particular elements of Applicant's claims, and that proper motivation to combine the Henneuse reference with these and the remaining references is shown in the Henneuse reference itself.

In addressing the Examiner's response, Applicant submits in this reply brief that: (1) while different references can be cited for different elements of a claim, it is impermissible to combine references in a way which changes the principle of operation of the primary reference; (2) in determining the differences between the prior art and the claims under 35 USC 103, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious; and (3) it is not enough that there is a motivation to combine references; rather, the motivation to combine must be such as to teach or suggest the claimed invention.

While different references can be cited for different elements of a claim,
it is impermissible to combine references in a way which changes the
principle of operation of the primary reference

The Examiner has cited the Davies reference as the primary reference against independent claims 1, 17 and 18. As to claim 1, the Examiner cites Davies as disclosing the steps of:

- a) providing a database of information including reservation information, said reservation information including at least one selection option, said option including a time and a date for an activity from at least one recreational facility; and
- b) receiving a selection from a first one of said participants using a client application of a selection option.

(see page 4 of Examiner's response)

The Applicant's Appeal Brief points out the inherent deficiencies in the Davies reservation system, and indeed the Examiner admits that Davies does not explicitly show the remaining elements of claim 1. However, the Examiner cites the Durand, Teemaster and Henneuse references for these remaining elements as outlined on pages 4 through 7 of the Examiner's Answer. After citing Durand for the claimed elements pertaining to partner profiles, the Examiner states that Teemaster shows

reservation information for a plurality of recreational facilities;
receiving a non-specific request pertaining to a plurality of facilities for at least one selection option; and
retrieving and transmitting, based on said received request, at least one selection option pertaining to at least one available reservation.

While Teemaster may suggest these items individually, Applicant submits that the Examiner's proposed combination of Teemaster and the remaining references with Davies would not teach or suggest the claimed invention and would run counter to the logic and principle of operation of Davies. Contrary to the Examiner's assertions, Applicant does not argue what particular claim elements the Examiner believes Davies shows, but Applicant submits that the Examiner's proposed combination of Davies with other references changes the principle of operation of Davies. This is not permissible in an obviousness determination, as noted in MPEP 2143.01 and the cases cited therein.

As noted in the Appeal Brief, the Davies et al. device is only capable of accessing a single golf course's reservation system at a time. The user of the Davies device does not interact in a series of requests and responses to the golf course reservation system; rather, the user blindly submits his or her desired preferences (see column 4, lines 20-40) with the hopes of receiving his or her desired tee time. Indeed, Davies did not foresee user interaction in a series of requests and responses, as the Davies "'Teephone' advantage is simply that the tee time request is 'unattended'." (col. 1, lines 49-50).

If one were to combine the teaching of Teemaster with Davies, one may conceive that additional courses might be made available through the Davies interface, but Davies could not be modified to present an interactive system allowing a user to enter a non-facility specific request for at least one selection option from among multiple facilities, retrieving and transmitting at least one option, and then receiving a user's selection as claimed in the present independent claims. Davies is hardwired as a purely two-step system (the user sends a request directly to the course's phone system and receives an answer) and it would run counter to the principle of operation of Davies to suggest that it could be combined with Teemaster and the remaining references to teach the invention of claim 1. Applicant submits that the same reasoning applies with regard to the Examiner's rejections of claims 17 and 18. For these reasons, Applicant submits that these independent claims and the claims dependent therefrom are thus allowable.

In determining the differences between the prior art and the claim under 35 USC 103, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious

The Examiner has cited the Henneuse reference in rejecting each of independent claims 1, 17, 18 and 21. As to claim 17, the Examiner has cited Henneuse as showing:

a number of openings available for one or more individuals to join said activity, and

receive indication information from said first participant using a client computer, said indication information including information necessary to notify a number of individuals of said selection, said number of individuals greater than said number of openings.

(see Examiner's answer, page 14)

As to claim 18, the Examiner has cited Henneuse as showing the same elements as above for claim 17 (see Examiner's answer, pages 17-18); however, the Examiner has noticeably not tracked the language of claim 18. As to claim 21, the Examiner has also cited Henneuse as showing the same elements as above for claim 17.

The Examiner's rejection includes the same parenthetical explanation of how Henneuse applies to claims 17, 18 and 21. Taken verbatim, the Examiner's language is as follows:

(i.e. generate one or more potential schedules along with requested individuals...matching participants to scheduling options and evaluating the different scheduling options...notifies available participant...notifies unavailable participant)(col. 4, lines 1-18 and 41-57))

This statement is unclear as to how it applies to Applicant's claims. Even upon reviewing the Examiner's cited passage in Henneuse, Applicant submits that Henneuse does not combine with the other cited references to teach the invention as claimed. In the cited passage, Henneuse describes receiving *reply* information from requested participants for a potential event, and organizing the replies such that, *after the event confirmation has been received and, optionally a venue scheduled*, the server application creates and sends a message to each available participant and each unavailable participant. The Examiner argues that such disclosure meets the language in claims 17, 18 and 21; however, the Examiner does not apply Henneuse to the claimed invention in context and as a whole. Rather, the Examiner has selected portions of claim language not shown in other references and applied Henneuse to that language, out of the context of the claims. The Examiner has thus applied Henneuse to the *differences* seen between the claimed invention and the Examiner's other cited references. MPEP 2141.02 requires that the claimed invention as a whole must be considered, not merely the differences between the claimed invention and the prior art.

As stated in the Appeal Brief, Henneuse does not teach or suggest the claimed invention in combination with the other cited references. In claims 17, 18 and 21, "said activity" refers to an activity from *at least one recreational facility*, and the user's "selection" refers to a selected selection option pertaining to at least one *available reservation*. There is simply no discussion in Henneuse of a number of openings available in connection with a reservation selection option, because there are in fact no reservations, much less a selection option associated with a reservation. There is further no discussion or suggestion within Henneuse of notifying a number of individuals greater than the number of openings available in connection with a reservation selection option, as claimed in claims 17, 18 and 21. Henneuse has no reference whatsoever to an event reservation having a limited number of "openings available"; Henneuse only refers to participants as being available or unavailable. Thus, there is no teaching in Henneuse pertinent to this element. For these reasons, Applicant submits that these independent claims and the claims dependent therefrom are thus allowable.

The motivation to combine references must be such as to
teach or suggest the claimed invention.

As discussed in the Appeal Brief, the Henneuse reference describes sending scheduling option information in the form of one or more dates and times (see col. 3, lines 16-20 and col. 5, lines 6-8) to potential event participants in order to determine participant availability for an event. The event information sent to potential participants does not include a *pre-selected, available, venue* reservation. Henneuse only contemplates the venue for an event after determining participant availability and obtaining selection of a time and date by the event scheduler (see col. 4, lines 31-40, col. 6, lines 2-10, and claims 7 and 16). In such a scenario, it is easily foreseeable that a scheduler may have to repeatedly obtain and review participant availability information if it turns out the originally selected time is not available at the venue. Henneuse even acknowledges that if the preferred venue reservation is not available, the scheduler can be asked to resubmit a confirmation for the event so that a proper venue can be reserved (see col. 4, lines 37-40, and claims 8 and 17).

For the reasons stated above, Applicant submits that Henneuse does teach or suggest the claimed invention in combination with the other cited references. On page 34 of the Examiner's Answer dated March 9, 2005, the Examiner cited the motivation "to use accurate availability (i.e. that the invited or requested participants are available to attend *before* scheduling the event) information to schedule the event" as the motivation for combining the Henneuse reference with the other references in rejecting claims 1, 17, 18 and 21 (emphasis added).

Applicant understands that there may be a motivation to combine Henneuse with another reference for the purposes of attempting to schedule an event *after* the availability of event partners has been ascertained. But this does not mean that Henneuse can be freely combined with other references for counter-suggestive reasons. Indeed, Applicant submits that there is *no motivation* to combine the Henneuse reference with the other references to achieve the *claimed invention*. Claims 17 and 21 call for "receiving indication information...including information necessary to notify a number of individuals of *said* selection, said number of individuals being greater than said number of available openings" associated with the selected option. Similarly, claim 18 calls for "notifying a number of individuals of *said* reservation, said number of individuals being greater than said number of openings available" for said reservation. In each case, the notification pertains to a selected, available reservation option, and the number of individuals to be notified is greater than the number of available openings of the selection option. There is nothing in Henneuse that teaches or suggests this, and it runs entirely counter to the teachings of Henneuse to notify a number of individuals of an available, selected reservation prior to receiving their acceptance.


Henneuse is also cited against independent claim 1 for disclosing "receiving acceptance information from at least one other participant..." and subsequently "receiving instructions...to book a reservation for the time and date and facility connected with said selection option". In claim 1, the reservation being booked relates to a time, date *and facility* connected to the selection option. Applicant submits that Henneuse does not teach or disclose receiving acceptance information for a

selected and determined-to-be-available reservation at a facility among a plurality of facilities, as claimed in claim 1. It is clear in Henneuse that venue availability is not known at the time participants are notified of possible meeting options.

The Examiner's stated motivation for combining the Henneuse reference with the other references cited against claim 1 is the motivation to use accurate availability information to schedule an event. Applicant submits that the availability information in Henneuse is explicitly only time and date information from the participants, and does not include a known-available venue reservation. One combining Henneuse with any of the other cited references would still not be able to solve the problems addressed by the presently claimed invention. For example, if one were to receive the participant time-and-date availability information of Henneuse and then schedule a tee time using Davies, the tee time would not be a known available time, and the user may be required to again pre-program their phone as in Davies to request an available reservation.

Accordingly, Applicant submits that the claims as amended are not shown or made obvious by any of the references of record, taken singly or in combination, and are thus allowable over the cited references. The remaining claims are dependent upon one of the amended independent claims and it is submitted that these dependent claims are similarly allowable over the cited references. It is respectfully requested that the Board remand this patent application back to the Examiner with the directive to issue a Notice of Allowance in this matter.

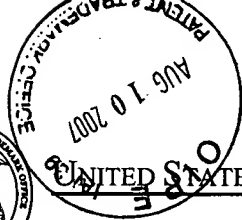
Respectfully submitted,



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